



Docket No. 00066CON

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Galloway et al.

Group Art Unit: 1752

Serial No.: 09/896,886

Examiner: Cynthia Hamilton

Filed: June 29, 2001

For: **PRINTING PLATES COMPRISING MODIFIED PIGMENT PRODUCTS**

Commissioner for Patents
Washington, D.C. 20231

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RESPONSE TO RESTRICTION REQUIREMENT

Sir:

In response to the Office Action mailed September 17, 2002, which sets forth a restriction requirement, Applicants elect, with traverse, the invention of Group 1a (claims 1-90) for further prosecution. Applicants respectfully submit, however, that the restriction requirement is improper, in whole or in part, for the reasons set forth herein and, therefore, request withdrawal of the restriction requirement.

The Manual of Patent Examining Procedure (M.P.E.P.) recites the requirement for a proper restriction requirement. In particular, the M.P.E.P. states:

There are two criteria for a proper restriction requirement between patentably distinct inventions:

(A) The inventions must be independent (see M.P.E.P. Section 802.01, Section 806.04, Section 808.01) or distinct as claimed (see M.P.E.P. Section 806.05 – Section 806.05(i)); *and*

(B) There must be a serious burden on the examiner if restriction is required (see M.P.E.P. Section 803.02, Section 806.04(a) – Section 806.04(i), Section 808.01(a), and Section 808.02).

(M.P.E.P. § 803 (emphasis added)). These are two separate criteria that must be satisfied to support a proper restriction requirement. The fact that *both* criteria must be satisfied is made all the more clear by the following statement in the M.P.E.P.:

If the search and examination of an entire application can be made without serious burden, the examiner *must* examine it on the merits, even though it includes claims to independent or distinct inventions.

(M.P.E.P. § 803 (emphasis added)). Thus, if the subject matter of the pending claims is such that there would be no serious burden on the examiner to search and examine all of the pending claims at the same time, the examiner is to do so, *even if* the pending claims are drawn to independent or distinct inventions.

With respect to the present application and the outstanding restriction requirement, Group Ia includes pending claims 1-90, which relate to a printing plate comprising a radiation-absorptive layer which comprises at least one modified pigment product. Various embodiments are disclosed in independent claims 1, 23, 36, 41, 46, 56, and 65. Group Ib includes pending claims 91 and 92, which relate to a method of imaging a printing plate of Group Ia. Group II includes pending claims 93 and 94, which relate to a flexographic printing plate comprising a radiation-absorptive layer which comprises at least one modified pigment product. Group III includes pending claims 95 and 96, which relate to a thermal transfer recording material comprising a photothermal layer which comprises at least one modified pigment product. Group IV includes pending claims 97 and 98, which relate to a proofing material comprising a radiation curable layer which comprises at least one modified pigment product. Group Va-Vf include pending claims 99-110, which all relate to a black matrix formed by applying a photosensitive coating on a clear substrate, wherein the photosensitive coating comprises at least one modified pigment product. For Group Va (pending claims 99 and 100), the modified pigment product comprises a pigment having attached at least one organic ionic group and at least one amphiphilic counterion. For Group Vb (pending claims 101-102), the modified pigment product comprises a pigment having attached at least one organic group

represented by the formula $-X-Sp-[A]_pR$ wherein A represents an alkylene oxide group. For Group Vc (pending claims 103 and 104), the modified pigment product comprises a pigment having attached at least one organic group represented by the formula $-X-Sp-[Vinyl]R$ wherein Vinyl represents an acrylic or styrenic homo- or copolymer. For Group Vd (pending claims 105 and 106), the modified pigment product comprises a pigment having attached at least one organic group represented by the formula $-X-Sp-[EI]R$ wherein EI represents an alkyleneimine-based polymer or copolymer. For Group Ve (pending claims 107-108), the modified pigment product comprises a pigment having attached at least one organic group represented by the formula $-X-Sp-[SMA]R$ wherein SMA represents a styrene-maleic anhydride polymer or derivative. For Group Vf (pending claims 109-110), the modified pigment product comprises a pigment that is at least partially coated with one or more polymer coatings.

A comparison of the claims of Groups Ia-Ib, II, III, IV, and Va-Vf makes it abundantly clear that the claims of these 11 groups have quite similar subject matter and overlap to such an extent that there will be no serious burden on the Examiner to search and examine all of the pending claims at the same time. In particular, all of the pending claims include a layer capable of being exposed to radiation that comprises a modified pigment product. For example, the printing plates of claims 1, 23, 36, 41, 46, 56, and 65 (Group Ia) comprise a radiation-absorptive layer comprising at least one modified pigment product. Similarly, claim 93 (Group II) pertains to a flexographic printing plate which comprises a radiation-absorptive layer comprising at least one modified pigment product. Flexographic printing plates are a specific type of printing plate used in image reproduction (see the "Description of the Related Art" section of the present application, paragraph 3) and are therefore a subset of the broader category of printing plates. In addition, the thermal transfer recording material of claim 95 (Group III) comprises a photothermal layer comprising a modified pigment product. Paragraph 77 of the present application describes how the thermal transfer recording material may be irradiated or exposed by a laser in the imaging process. Thus, the recording material of claim 95 includes an irradiated layer comprising a modified pigment. Paragraph 77 further teaches that thermal transfer recording materials are useful for color proofing in printing systems. Other proofing materials are discussed in paragraph 78. Thus, the proofing

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material of claim 97 (Group IV) comprises a radiation curable layer comprising a modified pigment product. Finally, the black matrices of claims 99-110 (Group Va-Vf) all comprise a photosensitive coating comprising a modified pigment product. Specific embodiments are disclosed in each of the claims of Groups Va-Vf for specific types of modified pigments. These are similar to the specific embodiments for the printing plates of claims 1-90 (elected group Ia), for which the examiner has not further restricted. Therefore, each of the restricted Groups of claims are interrelated and include a layer that can be exposed to radiation, such layer comprising a modified pigment product.

Furthermore, independent claim 91 (Group Ib) specifically relates to a method of imaging the printing plate of claim 1 (Group Ia). Clearly, a search of the printing plate of claim 1 would also encompass methods for their imaging.

The many relationships between the claims of these 11 groups illustrate that there would be no serious burden on the Examiner to search and examine the claims of Groups Ib, II, III, IV, and Va-Vf at the same time as searching and examining the claims of elected Group Ia.

In view of the foregoing remarks, Applicants respectfully request withdrawal of the restriction requirement, such that all of the pending claims are considered together. If, in the opinion of the Examiner, a telephone conference would expedite the prosecution of the present application, the Examiner is invited to call the undersigned attorney.

Respectfully submitted,

By:



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